

REMARKS

This is a full and timely response to the final Official Action mailed February 28, 2005. Reconsideration of the application in light of the following remarks is respectfully requested.

Claims 1-32 and 39-42 are currently pending for consideration. Claims 33-38 have been withdrawn from consideration under a Restriction Requirement.

With regard to the prior art, the outstanding Office Action rejected claims 1-4, 7, 9, 11, 13, 14, 16-19, 22, 26, 28, 29, 31 and 32 as unpatenable under 35 U.S.C. § 103(a) over the combined teachings of U.S. Patent No. 6,289,169 to Okuyama ("Okuyama") and U.S. Patent No. 5,892,536 to Logan et al. ("Logan"). The other dependent claims in the application were also rejected in view of Okuyama and Logan in combination with a variety of other secondary references. For at least the following reasons, these rejections are respectfully traversed.

Claim 1 recites:

A personal versatile recorder for recording any type of data comprising:
a central processing unit;
a data storage device;
a connection to a cable television system for receiving a signal comprising television programming and a data transport stream for transmitting any of streamed audiovisual content, multimedia files or software;
wherein said central processing unit selectively records said television programming and data from said data transport stream on said data storage device.

Similarly, independent claim 16 recites:

A method of receiving and recording television programming and any type of multimedia data with a personal versatile recorder, said method comprising selectively recording on a data storage device any of television programming, steamed audiovisual content, a multimedia file or software that is received by said personal versatile recorder in a composite signal that includes at least one data transport stream and a television signal.

In contrast, the combined teachings of Okuyama and Logan fail to teach or suggest a recorder or method of recording that includes receipt of a signal carrying *both* television programming and other data, such as multimedia files and software, where the television programming and other data are selectively recorded *on the same data storage device*.

Okuyama teaches a system in which television programming is recorded on either a Video Tape Recorder (VTR) or a DVD player. These devices, as explained by Okuyama, are suitable for recording television programming delivered, for example, as an MPEG digital transport stream. However, the VTR and DVD of Okuyama are not used to selectively store television programming *in addition to* other data such as multimedia files or software. According to Okuyama, “a recording/reproducing unit 42 of the DVD 4 is designed to record an inputted transport stream after converting it into a program stream (PS).” (Okuyama, col. 6, lines 12-14). Okuyama does not teach or suggest also storing other data such as software or a multimedia file on the VTR or DVD unit.

Parenthetically, the final Office Action seems confused as to what constitutes a multimedia file as claimed. According to Applicant’s specification, a multimedia file is, for example, a picture file, a graphics file, a video file or an audio file. (Claim 2). By definition, streamed audiovisual programming is *not* a “file.”

Similar to Okuyama, Logan only teaches recording video programming on a Video Cassette Recorder (VCR). (Logan, col. 10, lines 12-22). Obviously, a VCR is not also used to store other forms of data such as software or multimedia files. According to Logan, any other data is handled separately by a “sub-carrier system.” (Logan, col. 2, lines 25-39). Thus, Logan also does not teach or suggest a system or method, as claimed, in which a signal is

received carrying both television programming and other data such as software or multimedia files and selectively recorded on the same data storage device.

Thus, neither of the two cited references teach or suggest a recorder or method of recording that includes receipt of a signal carrying both television programming and other data, such as multimedia files and software, where the television programming and other data are selectively recorded on the same data storage device. Therefore, the combination of Okuyama and Logan fails to teach or suggest the features of the claims.

"To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)." M.P.E.P. § 2143.03. Accord. M.P.E.P. § 706.02(j). Therefore, for at least these reasons, the rejection of claims 1-32 and 39-42 should be reconsidered and withdrawn.

Additionally, claim 9 recites: "The recorder of claim 8, wherein said set-top terminal further comprises a secondary tuner for tuning said data transport stream, a second data transport stream, or a second selected channel from the signal received from said cable television system." In contrast, none of the cited prior art references teach or suggest a secondary tuner that is controlled by the same controlled by the same central processing unit (claim 10) as that selectively storing both television programming and other data in a common data storage device.

"To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)." M.P.E.P. § 2143.03. Accord. M.P.E.P. § 706.02(j). Therefore, Applicant respectfully requests that prior art by cited showing the secondary tuner as recited in claim 9 or the rejection of claim 9 be withdrawn.

Claim 13 recites: “The recorder of claim 1, further comprising an agent application executed by said central processing unit for identifying and recording or caching data from said data transport stream or television programming that matches parameters input by a user.” The final Office Action alleges that Okuyama teaches such an agent application executed by the central processing unit that is also controlling the selective recording of both television programming and other data. However, the Action does not indicate where Okuyama teaches such an agent application. Applicant respectfully requests that the Office either clarify where and how Okuyama teaches the claimed agent application or withdrawn the rejection of claim 13.


Claim 20 recites: “The method of claim 16, wherein said data of said data transport stream comprises software executable by said central processing unit to enable said central processing unit to manage and open any type of multimedia data file.” The final Office Action concedes that Okuyama and Logan fail to teach or suggest this subject matter, and so cites U.S. Patent No. 5,768,539 to Metz et al. (“Metz”) in proposed combination with Okuyama and Logan. However, the Action does not indicate how or where Metz teaches the claimed software that enables the management and opening of any type of multimedia data file. In contrast, Metz appears only concerned with the transmission of software and not multimedia data files. (Metz, abstract).

Consequently, the proposed combination of prior art references fails to teach or suggest the features of claim 20, and the Office has failed to indicate how or where such features are taught by the cited prior art. Therefore, the rejection of claim 20 should be reconsidered and withdrawn.

For the foregoing reasons, the present application is thought to be clearly in condition for allowance. Accordingly, favorable reconsideration of the application in light of these remarks is courteously solicited. If any fees are owed in connection with this paper which have not been elsewhere authorized, authorization is hereby given to charge those fees to Deposit Account 18-0013 in the name of Rader, Fishman & Grauer PLLC. If the Examiner has any comments or suggestions which could place this application in even better form, the Examiner is requested to telephone the undersigned attorney at the number listed below.

Respectfully submitted,

DATE: 28 April 2005


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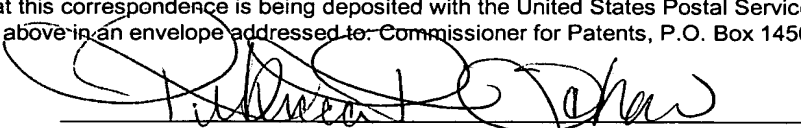
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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail on the date indicated above in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.


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